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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HISASHI SAIGA, YUJI SAWADA, KEISUKE IWASAKI,
MASAFUMI YAMANOUE, YOSHIHIRO KITAMURA,
HITOSHI HIROSE, and SHIGEKI KUGA

Appeal 2011-001305
Application 09/646,194¹
Technology Center 2100

Before ST JOHN COURTENAY III, THU A. DANG, and
JAMES R. HUGHES, *Administrative Patent Judges*.

HUGHES, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed on Sept. 14, 2000, claiming benefit from PCT/JP99/01137 filed Mar. 10, 1999, Japanese Application No. 10-071569, filed Mar. 20, 1998, Japanese Application No. 10-078757, filed Mar. 26, 1998, and Japanese Application No. 10-085400, filed Mar. 31, 1998. The Real Party in Interest is Sharp Kabushiki Kaisha.

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 28, 31-38, 41-47, 50, and 53-55, which are all the claims remaining in the application. Claims 1-27, 29, 30, 39, 40, 48, 49, 51, and 52 were cancelled during prosecution. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Invention

Appellants' invention relates to a data displaying device or an electronic book displaying device and more specifically to a data displaying device or an electronic book displaying device for displaying document data consisting of characters or images stored on a storage medium and a storage medium with a record of the data to be displayed. (Spec. 1, ll. 4-9).²

Representative Claim

Independent claim 28, reproduced below with the key disputed limitations emphasized, further illustrates the invention:

28. A data storage medium for use with a display device, said data storage medium having recorded thereon a plurality of *prespecified data units* that together define a single complete document,

wherein

each pre-specified data unit includes (i) a series of display elements for display by the display device, and
(ii) management elements associated with said display

² We refer to Appellants' Specification ("Spec.") and Appeal Brief ("Br.") filed March 17, 2010. We also refer to the Examiner's Answer ("Ans.") mailed Jul. 8, 2010.

elements, said management elements including all information necessary for the display device to display a predetermined sequence of said display elements as a scroll display, and

wherein

said predetermined sequence of said display elements includes an interval or intervals that sequentially together form a scroll path, each said interval being specified by a line segment defined by coordinate values of a starting point and an end point in a coordinate system defined by said pre-specified unit corresponding to coordinate values assigned to the display elements in said prespecified unit, such that the display elements forming the intervals defining said scroll path are respectively sequentially displayed from said starting point to said end point thereof as said scroll path is displayed by said display device.

Rejections on Appeal

1. The Examiner rejects claims 28, 31, 33-38, 41, 43-47, 50, and 53-55 under 35 U.S.C. § 103(a) as being unpatentable over Bienz (Bienz, et al., *Portable Document Format Reference Manual Version 1.2* (Adobe Systems Inc. Nov. 27, 1996)), Warnock (US Patent No. 5,634,064, issued May 27, 1997), and Saito (US Patent No. 6,599,324 B2, issued Jul. 29, 2003 (filed Mar. 11, 1998)).

2. The Examiner rejects claims 32 and 42 under 35 U.S.C. § 103(a) as being unpatentable over Bienz, Warnock, Saito, and further in view of Ota (Japanese Patent No. JP 5-323941, May 1993).

Grouping of Claims

Based on Appellants' arguments in the Brief, we will decide the appeal on the basis of representative claim 28. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

Under § 103, did the Examiner err in finding that the combination of Bienz, Warnock, and Saito would have taught or suggested “a *plurality of prespecified data units that together define a single complete document*” (emphasis added), within the meaning of independent claim 28?

ANALYSIS

Initially, we note that the features argued by Appellants merely constitute non-function descriptive material and statements of intended use of the recited applications. Representative apparatus claim 28 simply recites a “data storage medium having recorded thereon a plurality of pre-specified data units that together define a single complete document.” Claim 28 then recites two “wherein” clauses that describe the data recorded on the data storage medium. We conclude that the “wherein” clauses do not further limit the claimed invention either functionally or structurally. The data contained on the data storage medium constitutes non-functional descriptive material, which “does not lend patentability to an otherwise unpatentable computer-implemented product or process.” *Ex parte Nehls*, 88 USPQ2d 1883, 1889 (BPAI 2008) (precedential). *See Ex parte Curry*, 84 USPQ2d 1272, 1274 (BPAI 2005) (informative) (Fed. Cir. Appeal No. 2006-1003, *aff'd*, (Rule 36) (June 12, 2006) (“wellness-related” data in databases and

communicated on distributed network did not functionally change either the data storage system or the communication system used in the claimed method). *See also In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); *Nehls*, 88 USPQ2d at 1887-90 (discussing non-functional descriptive material). Similarly, “[a]n []intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates.” *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003). Accordingly we need not attribute any distinguishing character to the asserted claim features.

We give claim terminology the “broadest reasonable interpretation consistent with the [S]pecification” in accordance with our mandate that “claim language should be read in light of the [S]pecification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citations omitted).

Even if we, *arguendo*, were to ascribe some weight to the disputed claim limitations, we find Appellants’ arguments unavailing. We agree with and adopt the Examiner’s findings with respect to claim 28. (Ans. 4-8, 17-40)

In particular, Appellants’ contend that the cited references fail to teach or suggest “pre-specified data units” as recited in claim 28, because the PDF document format does not contemplate that each so-called “page” is to be a pre-defined unit in the case of the present invention. (Br. 25 and 28-29.) However, the Examiner has maintained that *the entire PDF file* itself constitutes a single “pre-specified unit” instead of the individual pages within a PDF file and relies on Saito to teach or suggest *separate files*

forming a document. (Ans. 8, 17, and 21.) Therefore, Appellants' arguments do not address the Examiner's specific findings.

Moreover, we agree with and adopt the Examiner's construction that the scrolling recited in claim 28 ("scroll path") broadly but reasonably includes moving from one article portion to another *within* a PDF file, and not *necessarily* between PDF files. (Ans. 18-19.) Thus, Appellants' contention that the cited references fail to teach or suggest sequential display of the pre-specified data units or files (Br. 28) is not persuasive because the display elements forming the display path can exist *within* the pre-specified unit or file.

Appellants further contend that the claimed scroll path is defined by a line segment starting point and a line segment end point in a coordinate system defined by said pre-defined unit according to coordinate values assigned to the display elements in a pre-specified unit. According to Appellants, "[t]his is to be distinguished from a scroll path of the *PDF Reference Manual* (emphasis added) that is alleged by the Examiner to be defined by [] a start point (i.e., an upper right corner) and an end point (i.e., a lower left corner)." (Br. 46.)

We note that the Examiner also relied on Warnock to teach or suggest the "thread," which specifies a particular navigation path through a document (beads) that make up a document. (Ans. 7, 32.) According to the Examiner, a "thread" defines a path through which one navigates (i.e., scrolls) through a document. Therefore, we find that the teachings of Warnock combined with the teachings of Bienz (PDF) collectively would have taught or suggested displaying a PDF article that includes one or more intervals that sequentially form a scroll path and each interval being

specified by a line segment defined by coordinate values defining a start point and end point. (*See* Ans. 7, 32-34.)

Further, with regards to the Examiner's findings, we note that Appellants did not file a Reply Brief to rebut the Examiner's findings and responses in the Answer. With respect to all claims before us on appeal, arguments which Appellants could have made but chose not to make have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Watts*, 354 F.3d 1362, 1368 (Fed. Cir. 2004). Therefore, Appellants' arguments are unavailing of error in the Examiner's rejection.

Thus, on this record, we conclude that the Examiner did no err in rejecting representative claim 28. Accordingly, we affirm the Examiner's rejection of claim 28 and independent claim 38 including limitations of similar scope and dependent claims 31, 33-37, 41, 43-47, 50, and 53-55, not separately argued with particularity.

Claims 32 and 42

As noted above, the Examiner rejects claims 32 and 42 as unpatentable over a separate combination of references. Appellants did not present separate arguments for the patentability of claims 32 and 42. Therefore, we affirm the Examiner's rejection of claims 32 and 42 for the same reasons discussed *supra*.

CONCLUSION OF LAW

Appellants have not shown that the Examiner erred in rejecting claims 28, 31-38, 41-47, 50, and 53-55 under 35 U.S.C. § 103(a).

DECISION

We affirm the Examiner's rejections of claims 28, 31-38, 41-47, 50, and 53-55 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED